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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SWERNOFSKY LAW GROUP PC 548 MARKET ST. SAN FRANCISCO, CA 94104				
EXAMINER				
LY, CHEYNE D				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/664,800

Applicant(s)

CLARK, GREGORY SCOTT

Examiner

CHEYNE D. LY

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 05, 2008 has been entered.
2. Claims 1-6 have been withdrawn.
3. Claims 7-20 are examined on the merits.

REMARKS

4. On pages 10-12, Applicant argues Hinckley does not describe "generating shipping papers or electronic records using the set of proprietary part numbers originally provided by the user translated from the set of true proprietary part numbers that summarizes a transaction involving the parts." Applicant's argument is not persuasive as discussed below. First, Due the vague and indefinite issued discussed above, the limitations of the true proprietary part numbers and true part numbers have been interpreted reasonably broad. Second, the disclosure of Hinckley as cited below renders the argued obvious over the art. For example, the argued limitation is directed to the optional limitations of "shipping papers or electronic records" wherein Hinckley describes the creation of purchase orders (POs) (page [0104]) wherein it would have been obvious to one of ordinary skill in the art to generate POs. (shipping papers or electronic records) using the set of proprietary part numbers originally provided by the user translated from the set of true proprietary part numbers that summarizes

a transaction involving the parts to reduce procurement cycle time and improve access to competitive pricing and available inventories by tracking IPN linked to each CS and CB account.

5. Third, Hinckley describes user interfaces (electronic records) using IPNs, UPNs, and MPNs such as providing access to corporate IPNs linked to IPNs (page 10, [0117] to [0118]).

Therefore, a prima facie case of obviousness has been established in regard to the argued limitations.

6. On page 12, Applicant argues the use of UPNs by Hinckley is distinct from the use of universal numbers of the instant application. Applicant's argument is not persuasive because describes the UPNs as claimed.

7. In regard to claims 17-20, Hinckley describes the new limitations as cited below.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. NEW MATTER.

10. Claims 19 and 20 recite the new limitation of the "step of determining availability comprises sending a second document to each of said different suppliers or manufacturers,

and the second document sent to a given one of said suppliers or manufacturers contains any universal part numbers and any other part numbers that are associated with said supplier or manufacturer" which has not been found in the instant specification, as originally filed. It is noted that the instant specification describes "an activity such as ascertain parts availability" (page 13, line 14) and "determines the relative availability of the parts...looking into parts from other companies." However, the disclosure does not provide written basis for the new limitations.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 7-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 7, lines 10, 12, and 15, recites "set of true proprietary part numbers" while line 15 recites "set of true part numbers" and the instant specification does not explicitly define true proprietary part numbers and true part numbers in order for one of ordinary skill in the art to distinguish one from the other. The metes and bounds of the claims are not clear because one of ordinary skill in the art would be able to ascertain whether the true proprietary part numbers and true part numbers are distinct numbers or the same numbers.

14. Due the vague and indefinite issued discussed above, the limitations of the true proprietary part numbers and true part numbers have been interpreted reasonably broad.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 7-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinckley (US 2002/0055886 A1).

17. In regard to claims 7, 9, and 10, Hinckley a method for translating a document that includes a set of proprietary part numbers over a network (page 8, [0097], especially, "Bill of Materials...to electronically create, share...BOM line items may be translated..."), including the steps of

receiving a first document (page 8, [0097], especially, "Bill of Materials...to electronically create, share...BOM line items may be translated...") including a first set of proprietary part numbers from a client workstation (page 3, [0043], especially, "IPN" for internal part number, and [0045], especially, "an input/output interface"), wherein a user of said client workstation...

translating said first set of proprietary part numbers into a set of proprietary part numbers into a set of universal part numbers (page 5, [0063]-[0068], especially, "Universal Part Number (UPN)"),

determining availability of one or more parts associated with said set of universal part numbers (page 1, [0006], e.g. looking for available components, page 2, [0028], e.g.

available component inventories, and page 7, [0081]-[0084], especially, "the user wants to

search...the MCR module may identify the corresponding UPN and capture records associated with the UPN);

storing in a first database a record of true proprietary part numbers and amounts of parts ordered or backordered (page 3, [0046], to page 4, [0047], e.g. Master Cross Reference data structure storing data...reference database...pending orders to identify a match based on component type, quantity, and price, and Figures 7 and 8, e.g. internal part number (IPN) and manufacture part numbers (MPN) represent “true proprietary part numbers”);

translating said set of true proprietary part numbers into numbers originally provided by the user (page 7, [0083], especially, “the MCR module may match all records that have the same UPN...return a listing of the unique IPN, CBs’ identification data MPN...”); and

generating shipping papers or electronic records (page 9, [0106], especially, “POs” and “invoices”).

18. However, Hinckley does not explicitly describe using the set of proprietary part numbers originally provided by the user translated from the set of true part numbers that summarizes a transaction involving the parts.

19. Hinckley describes an improvement that benefits component buyers (CBs) by reducing procurement cycle time and improved access to competitive pricing and available inventories (page 9, [0103]). “The order module may provide an integrated solution that enables CBs and CSs [component sellers] to collaborate electronically with all of the trading partners in the supply chains...creating POs” (page 9, [0106]). Further, Hinckley describes the

improvement “enable tracking IPN links to each CS and CB account”, and page 10, [0117]-[0120], e.g. IPNs and MPNs represent true proprietary part numbers).

20. One of ordinary skill in the art at the time of the invention would have been motivated by the improvement of Hinckley to generate the second using the set of proprietary part numbers originally provided by the user translated from the set of true part numbers that summarizes a transaction involving the parts such as IPNs to reduce procurement cycle time and improve access to competitive pricing and available inventories by tracking IPN linked to each CS and CB account. Therefore, it would have been obvious to one of ordinary skill in the art to generate the second document using the second set of proprietary part numbers such as IPNs.

21. In regard to claim 8, Hinckley describes each of said set of universal part numbers is associated with other part numbers such as may be associated with different suppliers and manufactures (page 5, [0062]-[0063], especially, UPN and “associated MPN” (manufacture part number).

22. In regard claim 11, Hinckley describes identifying what parties may create associations between part numbers or enter new part numbers (page 6, [0061], especially, “register and store the identity(s) of entities providing such inaccurate data...allow the system and/or system operators or administrators to prioritize the equivalency data...).

23. In regard to claims 12-16, Hinckley describes the memory (page 1, [0008] and FIG 3).
24. In regard to claims 17 and 18, Hinckley describes said universal part numbers are numerical, alpha-numerical, or part numbers involving symbols (page 5, [0063] and Figure 8).

25. In regard to claims 19 and 20, Hinckley describes said step of determining availability comprises sending a second document to each of said different suppliers or manufacturers, and the second document sent to a given one of said suppliers or manufacturers contains any universal part numbers and any other part numbers that are associated with said supplier or manufacturer (page 8, [0098], e.g. **ad hoc business-to-business** workflow modeling, including links to the enterprise system of record. It should be understood the design module may also be configured to support unstructured collaboration, which may enable design reviews (such as designing for manufacturability, serviceability, reliability, and supply chain availability, and page 9, [0103], e.g. creating a comprehensive audit trail and improving access to competitive pricing and available inventories).

CONCLUSION

26. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history

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information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

27. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is 571-272-8300.
28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.
29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo, can be reached on (571) 272-3642.

/Cheyne D Ly/

Primary Examiner, Art Unit 2168